

APR 2005

Effective on 12/08/2004
Fees pursuant to Consolidated Appropriations Act. 2005 (H.R. 4818)**FEE TRANSMITTAL**
For FY 2005☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$500.00)**Complete if Known**

Application Number	09/932,900
Filing Date	August 20, 2001
First Named Inventor	Claudia Dorenkamp et al.
Examiner Name	Lyle Alexander
Art Unit	1743
Attorney Docket No.	37105.0031

METHOD OF PAYMENT (check all that apply)

- ☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____
- ☒ Deposit Account Deposit Account Number: 08-2442 Deposit Account Name: Hodgson Russ LLP
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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
_____ - 20 or HP = _____ x _____ = _____				
HP = highest number of total claims paid for, if greater than 20				
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	
_____ - 3 or HP = _____ x _____ = _____				
HP = highest number of independent claims paid for, if greater than 3				

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____				

4. OTHER FEE(S)

Non-English Specification,	\$130 fee (no small entity discount)	Fees Paid (\$)
Other: <u>Appeal Brief</u>		<u>500.00</u>

SUBMITTED BY

SIGNATURE		Registration No. 37,729 (Attorney/Agent)	Telephone 716-856-4000
NAME (Print/Type)	George L. Snyder, Jr.		Date May 2, 2005

I hereby Certify that this Correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents,
P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 2, 2005.

Barbara Haggerty
Name

Barbara Haggerty
Signature

May 2, 2005
Date of Signature



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Barbara Haggerty

Name

Signature

May 2, 2005

Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/932,900
Applicant(s) : Claudia Dorenkamp et al.
Filed : August 20, 2001
Title : Apparatus For Treating Objects
TC/A.U. : 1743
Examiner : Lyle Alexander
Docket No. : 37105.0031

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief follows a Notice of Appeal mailed March 2, 2005, and is accompanied by a Fee Transmittal, a check in the amount of \$500.00 as payment of the fee required under 37 CFR 41.20(b)(2), and an acknowledgement postcard.

I. REAL PARTY IN INTEREST

The real party in interest is Leica Microsystems Nussloch GmbH, assignee of the present application.

II. RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences.

III. STATUS OF CLAIMS

The application as filed included claims 1-43.

Claims 2, 16, 21, and 37 are canceled.

Claims 1, 3-15, 17-20, 22-36, and 38-43 are rejected.

Claims 1, 3-15, 17-20, 22-36, and 38-43 are being appealed.

IV. STATUS OF AMENDMENTS

After the Final Office Action dated November 2, 2004, Applicants filed a first amendment on January 4, 2005 amending claims 1 and 20, which was entered as indicated in the Advisory Action dated February 10, 2005. The Advisory Action further indicated that the entered amendment did not place the application in a condition for allowance, and the rejections of claims 1, 3-15, 17-20, and 22-40 under 35 U.S.C. § 102 were dropped in favor of the 35 U.S.C. § 103 rejections of record.

Subsequently, Applicants submitted a second amendment ("Supplemental Amendment And Response To Final Office Action") via facsimile on February 23, 2005, which was not entered as indicated in the Advisory Action dated March 17, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1, 20, and 41 are the only independent claims on appeal. Claims 1 and 20 are Jepson claims sharing an identical preamble, which has been reproduced below with reference numerals added for sake of understanding:

In an apparatus (1) for treating cytological or histological specimens, said apparatus (1) having multiple processing stations

(2) and a transport device (4) for delivering said specimens into and out of said processing stations (2), a loading station (6) for loading with specimens or object carriers (5) carrying said specimens, and a removal station (7) for removing said treated specimens or said object carriers (5) carrying said treated specimens, the improvement comprising:

The characterizing limitations of claim 1 relate to the loading station (6) mentioned in the preamble, and are summarized as follows:

- the loading station (6) is embodied as a drawer capable of being opened and closed with respect to the apparatus (1), see paragraphs [0015] and [0023], and Fig. 1;
- the loading station has a plurality of processing stations allocated to it, see paragraphs [0006] through [0011], [0024], and [0025]; and
- the number of processing stations allocated to the loading station is selected by a user and can be varied, see paragraphs [0007], [0008], [0011], and [0025].

The characterizing limitations of claim 20 correspond to those of claim 1 summarized above, however they relate to the removal station (7) mentioned in the preamble, not to the loading station.

Claim 41 is another Jepson claim. The preamble of claim 41 is reproduced below with reference numerals added to assist understanding:

In a system having a plurality of sequentially arranged apparatuses (1) for treating cytological or histological specimens, each said apparatus (1) having multiple processing stations (2) and a transport device (4) for delivering said specimens into and out of said processing stations (2), a loading station (6) for loading with specimens to be treated or object carriers (5) carrying said specimens to be treated, and a removal station (7) for removing said treated specimens or said object carriers (5) carrying said treated specimens, the improvement comprising:

The characterizing limitation of claim 41 is that the transfer device (4) is operable to transfer the object carriers (5) from an upstream apparatus to the apparatus (1) with which the

transport device (4) is associated. This limitation is described at paragraphs [0018] and [0019] of the specification.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There are three grounds of rejection to be reviewed on appeal:

- 1) Claims 41-43 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 5,895,628 (Heid et al.);
- 2) Claims 41-43 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 6,635,225 (Thiem '225); and
- 3) Claims 1, 3-15, 17-20, 22-36, and 38-40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Heid et al., Thiem '225, or U.S. Patent No. 6,080,365 (Thiem '365) in view of U.S. Patent No. 5,578,268 (Champseix et al.).

VII. ARGUMENT

1. *Rejection of 41-43 under 35 U.S.C. § 102(b) as being clearly anticipated by Heid et al.*

A. *Claims 41 and 42*

It is Applicants' respectful position that Heid et al. does not teach or suggest a transfer device that is "operable to transfer said object carriers from an upstream apparatus to the apparatus with which said transport device is associated" as set forth in claim 41. The transfer device of Heid et al. includes a pair of horizontal parallel guide rails 8a and 8b, a crossbar 9 extending between the guide rails 8a and 8b for horizontal motion along the guide rails, a vertical guide 10 extending down from the crossbar 9 and movable horizontally along the crossbar at right angles to the direction of guide rails 8a and 8b, and a vertical slider 11 mounted on the vertical guide 11. See Heid et al. at column 4, lines 15-35. None of the basic X, Y, Z motion components of the transport device - namely guide rails 8a and 8b, crossbar 9, and vertical guide 10 - extends outside of housing part 1a to permit transfer of objects carriers in from an upstream apparatus. Consequently, claim 41 and claim 42 depending therefrom are considered patentable over Heid et al.

B. Claim 43

Claim 43 is patentable over Heid et al. for the reasons given immediately above with respect to parent claim 41. Moreover, Heid et al. does not contemplate connecting automatic stainer 1 with an upstream apparatus for data communication to enable treatment of specimens to be synchronized. Accordingly, it is urged that claim 43 is patentable over Heid et al.

2. Rejection of 41-43 under 35 U.S.C. § 102(b) as being clearly anticipated by Thiem '225

A. Claims 41 and 42

It is Applicants' respectful position that Thiem '225 does not teach or suggest a transfer device that is "operable to transfer said object carriers from an upstream apparatus to the apparatus with which said transport device is associated" as set forth in claim 41. The transfer motorized transport mechanism 6 of Thiem '225 includes a lifting device 7 with which transport baskets 4 are moved in steps in a straight line along a row of reagent containers 3. Lifting device 7 has parallel transport arms 24 on the left and right sides of stainer 1 that include transport notches 17 for receiving transport clips 16 of the transport baskets 4. The transport arms 24 operate in tandem to lift the baskets 4 and move them to the next container in the row. See Thiem '225 at column 4, lines 10-57 and Fig. 3. The stepwise transport device of Thiem '225 does not permit transfer of objects carriers in from an upstream apparatus. Consequently, claim 41 and claim 42 depending therefrom are considered patentable over Thiem '225

B. Claim 43

Claim 43 is patentable over Thiem '225 for the reasons given immediately above with respect to parent claim 41. Moreover, Thiem '225 does not contemplate connecting automatic stainer 1 with an upstream apparatus for data communication to enable treatment of specimens to be synchronized. Accordingly, it is urged that claim 43 is patentable over Thiem '225.

3. *Rejection of 1, 3-15, 17-20, 22-36, 38-40 under 35 U.S.C. § 103(a) as being unpatentable over Heid et al., Thiem '225, or Thiem '365 in view of Champseix et al.*

A. *Claims 1, 3-9, 17-20, 22-28, 31-36, and 38-40*

Claim 1 is directed to the improvement comprising “said loading station being embodied as a drawer capable of being opened and closed with respect to said apparatus” and “a plurality of processing stations allocated to said loading station, wherein the number of processing stations in said plurality of allocated processing stations is selected by a user and can be varied.” Claim 20 contains similar limitations, except they relate to a removal station, not a loading station.

Champseix et al. is cited to supply the drawer limitation of claim 1 and claim 20. Applicants submit that element 72 of Champseix et al., characterized as a “mobile drawer” by the Patent Office, is really an actuating plate that includes a nut 73 cooperating with a rotating screw (spindle) 74 to move the plate 72 linearly relative to guide block 70, and that a pair of ejector rods 71 carried by plate 72 engage cassette 3 to push it out onto a reception bin. See column 7, lines 40-58 and Figs. 17 and 18. It is not a drawer and it has no processing stations allocated to it. Rather, it is merely a pusher that pushes out a specimen carrier (the cassette). Thus, even if Heid et al., Thiem '225, or Thiem '365 were modified to include structure described by Champseix et al., there is no teaching of how to allocate processing stations to the pusher so that such stations can be drawn out of and moved into the apparatus, as is possible with a drawer.

It is also contended that one skilled in the art, at the time the invention was made, would not have been motivated to combine Champseix et al. with any of the primary references because the pusher device of Champseix et al. acts to expel cassettes 3 of closed blood sample tubes 9, and does not address the goal of more efficiently loading, processing and unloading cytological or histological specimens to improve working cycle time. In other words, the device of Champseix et al. provides little or no improvement in working cycle time over manual removal of a specimen carrier from a traditional removal station.

The primary references also fail to describe the “allocation” limitation of claims 1 and 20. The apparatus of Heid et al. has an opening 4 that acts as a loading station, however,

there are no processing stations (treatment containers 6a-j) allocated to the loading station 4. The specimen holder baskets are inserted into the loading station 4, where they remain until they are respectively taken up by the transport system for deposit into a processing station. See column 3, line 66 – column 4, line 5. So, there are no processing stations allocated to the loading station 4 in Heid et al. Likewise, the apparatus of Heid et al. includes an opening 5 that acts as a removal station, and specimen holder baskets are “set down in the removal station (5) after the complete staining program has been carried out.” Column 4, lines 5-6. Thus, there are no processing stations allocated to the removal station 5 in Heid et al.

Thiem ‘225 teaches a “loading station” comprising the first pair of side-by-side reagent containers 3 (the pair farthest to the left in Fig. 1 and removal station 8 having a pair of side-by-side collecting reagent containers 9. The stainer of Thiem ‘225 allows parallel but independent processing of specimens in the two rows. The choice not to load one of the rows does not effect cycle time of the other row. Also, the only possible plurality of allocated processing stations is a plurality of two. So, this reference does not suggest the “allocation” limitation of claim 1 or claim 20.

Finally, the apparatus of Thiem ‘365 is in the form of a circular array of processing stations (chemical containers 4 and paraffin containers 5). There is no teaching or suggestion in this reference of a loading station, or that any of the processing stations are allocated to a loading station. Because there is no loading station to which processing stations are allocated, it follows that the number of processing stations allocated to a loading station cannot be varied or selected by the user, as claimed. Therefore, Thiem ‘365 neither anticipates nor renders obvious the present invention as set forth in claim 1. Thiem ‘365, at Fig. 2, shows two adjacent paraffin stations 5 at which embedding is completed. If these are thought of as a removal station, claim 20 is nevertheless patentable because the number of processing stations (paraffin stations 5) in the plurality of processing stations allocated to the removal station cannot be varied or selected by the user, as set forth in claim 20.

B. Claims 10-15

Claims 10-15 depend directly or indirectly from claim 1, and thus are patentable for the reasons given above with respect to claim 1, as well as those presented below.

Thiem '225 describes a sensor system to alert a user when a collecting reagent container 9 of removal station 8 is completely filled by transport baskets 4. See Thiem '225 at column 3, lines 19-23; column 4, lines 25-28; and column 4, line 58- column 5, line 7. Aside from this, the references relied upon are silent regarding sensing.

Claim 10 depends from claim 1, and includes the further limitation that “said **loading station** is equipped with sensors for detecting **the presence of processing stations therein.**” (emphasis added). Therefore, claim 10 does not relate to whether a sample has been loaded, as assumed at the top of page 5 of the Final Office Action, but rather relates to the presence of a processing station in the loading station. This information is useful because, in a departure from the prior art, the number of processing stations allocated to the loading station is variable. The sensor system of Thiem '225 is unrelated to a loading station, and detects a different condition than the sensors of claim 10.

C. Claims 29-30

Claims 29-30 depend directly or indirectly from claim 20, and are patentable for the reasons stated above regarding claim 20 as well as those presented below.

Thiem '225 describes a sensor system to alert a user when a collecting reagent container 9 of removal station 8 is completely filled by transport baskets 4. See Thiem '225 at column 3, lines 19-23; column 4, lines 25-28; and column 4, line 58- column 5, line 7. Aside from this, the references relied upon are silent regarding sensing.

Claim 29 depends from claim 20, and includes the further limitation that “said removal station is equipped with sensors for detecting **the presence of processing stations therein.**” (emphasis added). Therefore, claim 29 does not relate to whether a sample has been loaded, as assumed at the top of page 5 of the Final Office Action, but rather relates to the presence of a processing station in the removal station. This information is useful because, in a departure from the prior art, the number of processing stations allocated to the removal station is variable. The sensor system of Thiem '225 detects a different condition than the sensors of claim 29.

VIII. CLAIMS APPENDIX

1. In an apparatus for treating cytological or histological specimens, said apparatus having multiple processing stations and a transport device for delivering said specimens into and out of said processing stations, a loading station for loading with specimens or object carriers carrying said specimens, and a removal station for removing said treated specimens or said object carriers carrying said treated specimens, the improvement comprising:
 said loading station being embodied as a drawer capable of being opened and closed with respect to said apparatus; and
 a plurality of processing stations allocated to said loading station, wherein the number of processing stations in said plurality of allocated processing stations is selected by a user and can be varied.
3. The improvement as defined in Claim 1, wherein up to four processing stations can be allocated to said loading station.
4. The improvement as defined in Claim 1, wherein said plurality of processing stations comprises selectable processing stations each having a specific function.
5. The improvement as defined in Claim 1, wherein said plurality of processing stations are allocated to said loading station by means of said transport device.
6. The improvement as defined in Claim 1, wherein said plurality of processing stations can be allocated manually to said loading station.
7. The improvement as defined in Claim 6, wherein said plurality of processing stations are bolted onto said loading station.
8. The improvement as defined in Claim 6, wherein said plurality of processing stations are clamped onto said loading station by means of a bracket.

9. The improvement as defined in Claim 1, wherein said plurality of processing stations are embodied as containers for said object carriers.
10. The improvement as defined in Claim 1, wherein said loading station is equipped with sensors for detecting the presence of processing stations therein.
11. The improvement as defined in Claim 10, wherein said sensors identify the number of processing stations in said plurality of processing stations.
12. The improvement as defined in Claim 1, wherein said loading station is equipped with sensors for detecting the presence of said object carriers located in said plurality of processing stations.
13. The improvement as defined in Claim 12, wherein said sensors identify the number of object carriers in said plurality of processing stations.
14. The improvement as defined in Claim 12, wherein the occupancy of said object carriers present in said loading station is indicated acoustically.
15. The improvement as defined in Claim 12, wherein the occupancy of said object carriers present in said loading station is indicated optically.
17. The improvement as defined in Claim 1, wherein said drawer is automatically openable and closable.
18. The improvement as defined in Claim 1, wherein said object carriers are loaded from said plurality of processing stations in said loading station to desired ones of said multiple processing stations of said apparatus by said transport device.
19. The improvement as defined in Claim 1, wherein said transport device is embodied as a robot arm having a gripper located at an end thereof.

20. In an apparatus for treating cytological or histological specimens, said apparatus having multiple processing stations and a transport device for delivering said specimens into and out of said processing stations, a loading station for loading with specimens or object carriers carrying said specimens, and a removal station for removing said treated specimens or said object carriers carrying said treated specimens, the improvement comprising:
 said removal station being embodied as a drawer capable of being opened and closed with respect to said apparatus; and
 a plurality of processing stations allocated to said removal station, wherein the number of processing stations in said plurality of processing stations is selected by a user and can be varied.
22. The improvement as defined in Claim 20, wherein up to four processing stations can be allocated to said removal station.
23. The improvement as defined in Claim 20, wherein said plurality of processing stations comprises selectable processing stations each having a specific function.
24. The improvement as defined in Claim 20, wherein said plurality of processing stations are allocated to said removal station by means of said transport device.
25. The improvement as defined in Claim 20, wherein said plurality of processing stations can be allocated manually to said removal station.
26. The improvement as defined in Claim 25, wherein said plurality of processing stations are bolted onto said removal station.
27. The improvement as defined in Claim 25, wherein said plurality of processing stations are clamped onto said removal station by means of a bracket.
28. The improvement as defined in Claim 20, wherein said plurality of processing stations are embodied as containers for said object carriers.

29. The improvement as defined in Claim 20, wherein said removal station is equipped with sensors for detecting the presence of processing stations therein.
30. The improvement as defined in Claim 29, wherein said sensors identify the number of processing stations in said plurality of processing stations.
31. The improvement as defined in Claim 20, wherein said removal station is equipped with sensors for detecting the presence of said object carriers located in said plurality of processing stations.
32. The improvement as defined in Claim 31, wherein said sensors identify the number of object carriers in said plurality of processing stations.
33. The improvement as defined in Claim 31, wherein the occupancy of said object carriers present in said removal station is indicated acoustically.
34. The improvement as defined in Claim 31, wherein the occupancy of said object carriers present in said removal station is indicated optically.
35. The improvement as defined in Claim 33, wherein complete filling of said removal station, and thus the need for removal, is indicated acoustically.
36. The improvement as defined in Claim 34, wherein complete filling of said removal station, and thus the need for removal, is indicated optically.
38. The improvement as defined in Claim 20, wherein said drawer is automatically openable and closable.
39. The improvement as defined in Claim 20, wherein said object carriers are loaded from desired ones of said multiple processing stations of said apparatus to said plurality of processing stations in said removal station by said transport device.

40. The improvement as defined in Claim 20, wherein said transport device is embodied as a robot arm having a gripper located at an end thereof.
41. In a system having a plurality of sequentially arranged apparatuses for treating cytological or histological specimens, each said apparatus having multiple processing stations and a transport device for delivering said specimens into and out of said processing stations, a loading station for loading with specimens to be treated or object carriers carrying said specimens to be treated, and a removal station for removing said treated specimens or said object carriers carrying said treated specimens, the improvement comprising:
said transfer device being operable to transfer said object carriers from an upstream apparatus to the apparatus with which said transport device is associated.
42. The improvement as defined in Claim 41, wherein said transfer device is further operable to transfer said object carriers from the apparatus with which said transport device is associated to a downstream apparatus.
43. The improvement as defined in Claim 41, wherein said apparatuses in said system are connected to communicate data with one another, whereby treatment of said specimens can be synchronized.

IX. EVIDENCE APPENDIX

There is no evidence to list in this appendix.

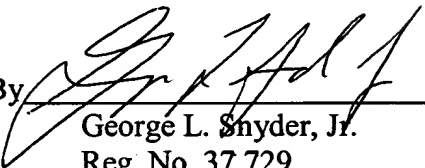
X. RELATED PROCEEDINGS APPENDIX

There are no other related proceedings.

Respectfully submitted,

HODGSON RUSS LLP

By



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